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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/696,815   | 10/30/2003  | Jayant D. Patel      | 038190/270421       | 1312             |
| 826  | 7590        | 03/31/2004           | EXAMINER            |                  |
| ALSTON & BIRD LLP<br>BANK OF AMERICA PLAZA<br>101 SOUTH TRYON STREET, SUITE 4000<br>CHARLOTTE, NC 28280-4000 |             |                      | BOCHNA, DAVID       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3679                |                  |

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                             |                  |
|------------------------------|-----------------------------|------------------|
| <b>Office Action Summary</b> | Application No.             | Applicant(s)     |
|                              | 10/696,815                  | PATEL ET AL.     |
|                              | Examiner<br>David E. Bochna | Art Unit<br>3679 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Behrens et al.

In regard to claim 1, Behrens et al. discloses a sleeve comprising:

A core 12 of the sleeve having an inner surface and an outer surface;

A first layer 11 bonded to the inner surface to the inner surface of the core; and

A second layer 13 bonded to the outer surface of the core, wherein the second layer is a material having a lower coefficient of friction than the first layer (second layer is glass where the first layer is glass embedded in resin which would raise its coefficient of friction).

In regard to claim 2, the first layer 11 is an elastomer-coated fabric layer (glass fibers).

In regard to claim 3, the first layer 11 and the second layer 13 are longer than the core, such that the first and second layer may be bonded together.

In regard to claim 5, the core 12 may be made of plastic foam.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behrens et al.

Behrens et al. discloses a sleeve with a foam core 12 as described above, but does not specifically disclose that the core is elastomeric. However, it would have been obvious to make the core out of elastomeric foam because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niggemeier et al.

In regard to claim 1, Niggemeier et al. discloses a sleeve comprising:

A core SS of the sleeve having an inner surface and an outer surface;

A first layer UB bonded to the inner surface to the inner surface of the core; and

A second layer OB bonded to the outer surface of the core. However, Niggemeier et al. does not specifically disclose that the second layer is made from a material having a lower coefficient of friction than the first layer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the second layer from a material having a lower coefficient of friction because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regard to claim 2, the first layer UB is an elastomer-coated fabric layer.

In regard to claim 3, the first layer UB and the second layer OB are longer than the core, such that the first and second layer may be bonded together.

In regard to claim 4, further comprising a third layer MS bonded to the second layer proximate a medial portion of the sleeve.

In regard to claims 5 and 6, the core SS is made of foam, but Niggemeier et al., but does not specifically disclose whether the core is elastomeric or plastic. However, it would have been obvious to make the core out of elastomeric or plastic foam because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

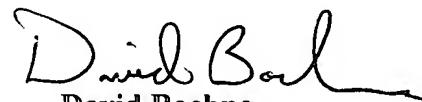
*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paasonen et al., Mueller et al., Shukushima et al., Williamson, Nordstrom, Gerholt et al., Merkwacz, Skinner, Cranston and EPO publication 38,051 all disclose similar sleeves common in the art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (703) 308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

  
David Bochna  
Primary Examiner  
Art Unit 3679  
March 29, 2004